

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Christian L. Struble

Group Art Unit: 3622

Serial No.: 09/894,213

Examiner: Alvarez, Raquel

Filed: June 27, 2001

Docket No. 10010610-1

For: **System and Method for Controlling the Presentation of Advertisements**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed October 7, 2008 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to points made in Applicant's Appeal Brief. Applicant addresses those responses in the following.

1. Thibadeau Does Not Disclose a Method for Controlling Advertisements

In the Appeal Brief, Applicant noted that, contrary to that expressed in the final Office Action, Thibadeau does not teach a "method for controlling the presentation of advertisements." The Examiner has now explicitly conceded this point on pages 5 and 6 of the Examiner's Answer. Applicant acknowledges the concession.

2. Thibadeau Does Not Disclose a Sensing Unit for Receiving Local Weather Condition Information

Applicant also noted in the Appeal Brief that, contrary to that implied by the Examiner, Applicant is not merely claiming "receiving local weather information." Instead, Applicant claims "receiving local weather condition information from a sensing unit that is separate from the computing device". Thibadeau neither teaches nor suggests a "sensing unit" that receives "local weather condition information".

On page 6 of the Examiner's Answer, the Examiner argues that Thibadeau teaches such a sensing unit given that Thibadeau teaches the use of a barometer. In reply, Applicant notes that Thibadeau's barometer is *not* described as receiving or collecting "weather condition information". Instead, Thibadeau's barometer is only described as being used to determine the altitude of Thibadeau's receiver. Again, Thibadeau is not concerned about local weather conditions. Instead, Thibadeau is

concerned about determining the location (latitude, longitude, and altitude) of a receiver to determine what information to send to the receiver. Therefore, contrary to that alleged by the Examiner, Thibadeau does not in fact determine target messages to send to a user “based on the measured weather.”

3. Dubious Combination of the References and Modification of Thibadeau’s System

Later in the Appeal Brief, Applicant noted that the Examiner’s argument that it would have been obvious to have replaced the warning messages described by Thibadeau with the advertisements described by Helferich lacks merit. Although Thibadeau teaches filtering “*emergency weather information*,” based upon the *location* of the set-top receiver that receives the information, there is simply no basis for the argument that such filtering would render obvious filtering *advertisements* based upon *local weather conditions*, at least without improper hindsight to Applicant’s own disclosure. It is clear that the proffered combination of the references and the modification of the Thibadeau reference has been manufactured with reference to Applicant’s claims with the goal of rejecting those claims.

In the Examiner’s Answer, the Examiner presents various justifications for the Examiner’s combination and modification. On page 6, the Examiner asserts that it is improper for Applicant to have “attacked the references individually.” In reply, Applicant notes that it is impossible to explain why the applied references fail to teach or suggest the claimed invention without addressing their individual shortcomings. Moreover, Applicant’s “attacks” have been limited to comments on how the various disclosures

identified by the Examiner do not in fact disclose or suggest the claim limitations the Examiner alleges they do. As such, Applicant submits that Applicant has properly addressed the rejections and the references cited within those rejections.

Also on page 6 of the Examiner's Answer, the Examiner identifies Thibadeau's discussion of "commercial services". In reply, Applicant notes that while Thibadeau mentions such services, Applicant reiterates that it is Applicant's position that there is no basis for the alleged obviousness of modifying Thibadeau's system to filter advertisements *based upon local weather conditions*. Although Helferich describes sensing temperature and tailoring messages based upon that sensed temperature, there is simply no reasonable basis for adding that form of sensing/messaging to the Thibadeau system, absent improper hindsight to Applicant's own disclosure.

In response to Applicant's point about the clear absence of a suggestion or motivation supplied by the prior art to make the Examiner's combination and modification, the Examiner on page 7 of the Examiner's Answer notes that "the skilled in the art is presumed to have some knowledge in the art." Applicant agrees with that statement. However, through this point in the proceedings, the Examiner has failed to provide a reasonable explanation as to why such a person would have conceived of Applicant's claimed inventions. Clearly, the only suggestion or motivation that would lead such a person to Applicant's inventions from the Thibadeau and Helferich disclosures comes from Applicant's own disclosure. Although Applicant acknowledges that the knowledge of the person of skill in the art is to be considered, the Examiner must not rely on improper hindsight. Indeed, the Supreme Court recently affirmed this in the KSR decision. See *KSR v. Teleflex*, 550 U.S. ___ (2007).

Moreover, Applicant notes that the Examiner's presumption that Thibadeau "teaches filtering messages based on the measured weather condition" is false. Again, Thibadeau uses altitude, not a local weather condition, to determine what information to transmit. In view of that fact, the basis for the Examiner's position on obviousness is false and, because of that, that position is flawed.

On page 8 of the Examiner's Answer, the Examiner responds to Applicant's point that the rejections are based on improper hindsight by citing legal boilerplate. In reply, Applicant notes that the underlying facts make it clear that the Examiner developed the rejections based not upon the knowledge of a person having ordinary skill in the art but on the terms present in Applicant's claims. If the Examiner was in fact correct, and it would have been reasonable for a person having ordinary skill in the art to have independently invented Applicant's inventions in view of the Thibadeau and Helferich references and his or her own "knowledge," the Examiner would have been able to explain this based upon the underlying facts and logic and would not need to simply regurgitate legal boilerplate.

4. No Disclosure/Suggestion of the "Fuel Pump" Application

Applicant also noted in the Appeal Brief in relation to claim 7 that neither Thibadeau nor Helferich says anything about a display unit that is mounted "to a fuel pump". To account for this deficiency of the applied references, the Examiner stated: "Official notice is taken that it is old and well known in gas stations and the like to have advertisements display on a fuel pump in order to induce the customers to make purchases while pumping gas." While it may be true that fuel pump displays are known,

this does *not* change the fact that it was not known to present on a fuel pump display advertisements that are “based upon the received weather condition information”.

On page 8 of the Examiner’s Answer, the Examiner reiterates the position that displays on fuel pumps are known. Applicant does not dispute this. Applicant emphatically disputes, however, that the Thibadeau and Helferich references render obvious *the method of claim 1 being performed on a fuel pump*. Simply stated, there is no legitimate basis for practicing that method on a fuel pump. Thibadeau’s disclosure is limited to receivers, such as set-top boxes, while Helferich’s disclosure is limited to cell phones. Applicant cannot contemplate how the Examiner could reasonably conclude that a person having ordinary skill in the art would have envisioned the claimed fuel pump application in view of Thibadeau’s set-top box and Helferich’s cell phone discussion. Clearly, the Examiner is not considering claim 7, which incorporates claim 1, as a whole and is instead treating the words contained in claim 7 in a vacuum. It appears that the Examiner believes that all that is necessary for an obviousness rejection is to find each of the limitations in the prior art across multiple references and that there is no need to connect the dots, i.e., provide a rational explanation as to why a person having ordinary skill in the art would have considered combining those references together. Applicant notes that the KSR decision did *not* excuse examiners from explaining why a claimed invention or feature would have been obvious in view of prior art teachings.

As a further matter, given that neither Thibadeau nor Helferich say anything about fuel pumps it is likewise clear that, once again, the Examiner is relying on improper hindsight to Applicant’s own disclosure.

5. Unaddressed Limitations


Applicant finally notes for the record that the Examiner did not address several of the limitations Applicant addressed in the Appeal Brief, including limitations from claims 9, 19, 24, 25, 26, 29, 30. In view of that fact, Applicant respectfully submits that the Examiner has conceded to Applicant's arguments presented in the Appeal Brief in regard to those claims.

With particular reference to independent claims 26 and 29, Applicant notes that those claims are different in scope than independent claim 1. In particular, claims 26 and 29 both explicitly recite receiving "local weather forecast information" and selecting advertisements based upon that "local weather forecast information". It is clear that neither Thibadeau nor Helferich describes the use of any such "forecast" information. Again, Thibadeau is only concerned about receiver position, and while Helferich describes measuring a current temperature with a cell phone, such a measurement cannot properly be interpreted as providing a weather "forecast". In view of those facts, each of claims 26-30 are clearly allowable over Thibadeau and Helferich.

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,



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